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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,957

08/11/2005

David John Hughes

50698

3769

26748

7590

08/28/2008

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EXAMINER

SZNAIDMAN, MARCOS L

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

08/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,957	<b>Applicant(s)</b> HUGHES ET AL.	
	<b>Examiner</b> MARCOS SZNAIDMAN	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-7,9 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4 pages / 12/14/04</u> .                                      | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to applicant's reply filed on May 6, 2008.

#### ***Election/Restrictions***

Applicant's election with traverse of Group II (claims 8 and 10) and compound I-1 as the elected species in the reply filed on May 6, 2008 is acknowledged. The traversal is on the ground(s) that the structures of Claim 8 represented by general formula IK and the structures of claim 9 (structures 9, (a 10 and 11) can be searched without burden. This is not found persuasive because the structures of claim 9 (substituted piperidines) are completely different than the structure of claim 9 which belongs to spiro indolines, and they belong to different classes and subclasses and hence will require separate queries and will cause a search burden,

Since the elected species is free of prior art, examination was expanded to the following species: 1-phenyl-1'-n-propylspiro [indoline-3,4'-piperidine] (CAS# 69620-57-1).

The requirement is still deemed proper and is therefore made FINAL.

#### ***Status of Claims***

Amendment of claims 9 and 10; and addition of claims 11-15 is acknowledged

Claims 1-15 are currently pending and are the subject of this office action.

Claims 1-7, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic

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or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 6, 2008. Claim 15 is also withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species (newly examined species: 1-phenyl-1'-n-propylspiro [indoline-3,4'-piperidine] (CAS# 69620-57-1)).

Claims 8 and 10-14 are presently under examination.

### ***Priority***

The present application is a 371 of PCT/GB03/02424 filed on 06/04/2003, and claims priority to foreign application UNITED KINGDOM 02137 5.6 filed on 06/14/2002.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoechst (GB 1603030).

Claims 8, and 11-14 recite a compound of formula IK (see claim 8). For claims 8 and 11-14 Hoechst teach the following compound: 1-phenyl-1'-n-propylspiro [indoline-3,4'-piperidine] (CAS# 69620-57-1) (see example 14 on page 11) that reads on general structure IK (see claim 8) and all the limitations of claims 11-14.

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Claim 10 further limits claim 8, wherein a composition comprises an insecticidally, acaricidally or nematocidally effective amount of: 1-phenyl-1'-n-propylspiro [indoline-3,4'-piperidine] (species examined). According to the specification (see page 90, lines 17-19), an insecticidally, acaricidally or nematocidally effective amount is defined as: a composition that comprises by weight 0.0001% to 95%, more preferably 1% to 85%, for example 5 to 65% of active ingredient.

For claim 10, Hoechst further teaches (see page 7, lines 31-39) that these compounds can be part of a composition or preparation further comprising diluents, carriers, etc.; and that the preparations should contain at least 0.5% of active compound, which anticipates the 0.0001% to 95% by weight concentration of the instant application.

The statement in claim 10: "an insecticidal, acaricidal or nematocidal" is considered an intended use and does not add any new limitation to the claim. *Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (fed. Cir. 2002). "The recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is

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(571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/  
Examiner, Art Unit 1611  
August 20, 2008

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611